



#4/Election
Patent
Attorney Docket: 265/225
4-30-03
C. Moore

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

Edgar A. MENDOZA, et al.

Serial No.: 09/941,349

Filed: August 28, 2001

For: INTEGRATED OPTIC DEVICES
AND PROCESSES FOR THE
FABRICATION OF INTEGRATED
OPTIC DEVICES

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) **Group Art Unit:** 2874
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) **Examiner:** Sanghavi, Hemang
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RESPONSE TO RESTRICTION REQUIREMENT

Commission for Patents
Washington, D.C. 20231

Sir:

In response to the election/restriction requirement mailed December 17, 2002, invention II is provisionally elected with traverse.

The December 17, 2002 Election/Restriction Requirement states that inventions I and II are distinct because the product of invention II can be made by another and materially different process. In particular, the Election/Restriction Requirement states that "in the instant case the product as claimed can be made by ... a process such as an epitaxial growth process or etching/masking process." However, as demonstrated below, a materially different process cannot be used to produce the products claimed in claims 101-136.

CERTIFICATE OF MAILING
(37 C.F.R. § 1.8a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to the Commissioner for Patents, Washington, D.C., 20231.

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Claim 101 is a product by process claim that requires the use of a process corresponding to that claimed in claim 1. Claims 102-136 depend from claim 101 and thus are also product by process claims that, at a minimum, require the use of the process steps set forth in claim 101. In view of the foregoing, the products claimed by claims 101-136 are not produced by a materially different process.

With respect to product claims 137-144, each of these claims require a photosensitive sol-gel derived glass device layer disposed on a substrate. As such, the products of claims 137-144 cannot be fabricated from an epitaxial process or simply any etching/masking process.

The present restriction requirement is also improper because not only must the Examiner show that the inventions are distinct, but the Examiner must also show that absent the restriction requirement a serious burden would be placed on the Examiner. (See MPEP § 803.) Here, the Examiner has failed to make any showing relating to burden.

REQUEST FOR RECONSIDERATION

In view of the foregoing, reconsideration and withdrawal of the election/restriction requirement set forth in the December 17, 2002 Office Action is respectfully requested.

Respectfully submitted,

JONES DAY

Dated: April 17, 2003

By: 

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